



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,433	04/15/2005	Takeshi Ito	KUZ-0024	8651

7590 05/20/2009  
Jane Massey Licata or Kathleen A Tyrrell  
Licata & Tyrrell  
66 East Main Street  
Marlton, NJ 08053

EXAMINER
----------

YOUNG, MICAH PAUL

ART UNIT	PAPER NUMBER
----------	--------------

1618

MAIL DATE	DELIVERY MODE
-----------	---------------

05/20/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/531,433	<b>Applicant(s)</b> ITO ET AL.	
	<b>Examiner</b> MICAH-PAUL YOUNG	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,3,6,7,13,14,16,17 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,6,7,13,14,16,17 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1618

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/13/09 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 3, 6, 7, 13, 14, 16, 17, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the disclosures of Hori et al (USPN 5,814,032 hereafter '032). The claims are drawn to a transdermal patch formulation comprising a polyisobutylene mixture, a mineral oil and fentanyl.

Art Unit: 1618

The '032 patent discloses a pressure sensitive adhesive formulation comprising a mixture of high and low molecular weight (polyisobutylene in a ratio of 1:3 (high: low) (Table 1). The polyisobutylene is present in a concentration from 50-80% (col. 4, lin. 1-5). The formulation comprises fentanyl (col. 3, lin. 50-5) present in a concentration of 0.01-20 parts by weight of 10 parts (0.01-20%) (col. 3, lin. 55-65). The formulation further includes liquid paraffin and isopropyl myristate (col. 5, lin. 35-60). The compounds are present in an amount approximately 0.5-20 parts by weight based on 100 parts (0.5-20%) (col. 6, lin. 8-16). The pressure sensitive adhesive layer measures 25 square cm and is 200 microns thick (col. 8, lin. 10-20). The concentrations of the reference overlap those of the instant invention, and would obviate the instant claims. The specific concentrations would be arrived at through routine experimentation by those of ordinary skill in the art. Also the reference is silent to the specific molecular weights of the polyisobutylene however high and low molecular weight polymers are well known and similarly weighted polymers are used in combination (col. 4, lin. 18-22). These limitations would be obvious variants and modification well within the level of skill in the art.

With these things in mind it would have been obvious to follow the teachings and suggestions in the art to modify and perfect the concentrations of the components in order to provide a stable long term transdermal device useful in topical drug delivery. One of ordinary skill in the art would have been motivated to modify the concentrations of the components through routine experimentation since they would provide the optimal results for drug delivery. These modifications would have been obvious and resulted in a stable and safe topical formulation.

#### ***Response to Arguments***

Art Unit: 1618

Applicant's arguments filed 3/13/09 have been fully considered but they are not persuasive. Applicant argues that:

Since the Hori patent requires a water absorption component it does not obviate the instant claims since no such component is required by the instant claims.

Regarding this argument it remains the position of the Examiner that the Hori patent continues to obviate the instant claims. The Hori patent discloses a transdermal patch comprising polyisobutylene, fentanyl and a mineral oil on a backing sheet. The claims recite that the patch *consists essential of* these components yet does not foreclose the inclusion of other components. Further these components only make up to 94.2% of the total mass of the patch, leaving room for other components, like those of the Hori patent. Although the omission of the ingredient may be an indicia of unobviousness the claims do not omit the inclusion of water absorbing components. As such the Hori patent, in disclosing the same components in the same concentration for the same intended use of skin application continues to obviate the instant claims. For these reasons the claims remain obviated.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICAH-PAUL YOUNG whose telephone number is (571)272-0608. The examiner can normally be reached on Monday-Friday 7:00-4:30; every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/  
Supervisory Patent Examiner, Art Unit 1618

/MICAHA-PAUL YOUNG/  
Examiner, Art Unit 1618